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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,666	12/27/1999	KEITH C. THOMAS	98-1176	9062
24333	7590	12/28/2007	EXAMINER	
GATEWAY, INC.			ALVAREZ, RAQUEL	
ATTN: Patent Attorney				
610 GATEWAY DRIVE			ART UNIT	
MAIL DROP Y-04			PAPER NUMBER	
N. SIOUX CITY, SD 57049			3622	
			MAIL DATE	DELIVERY MODE
			12/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/472,666	<b>Applicant(s)</b> THOMAS, KEITH C.	
	<b>Examiner</b> Raquel Alvarez	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19,22-25,33-39 and 55-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19,22-25,33-39 and 55-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This office action is in response to communication filed on 10/9/2007.
2. Claims 19, 22, -25, 33-39 and 55-70 are presented for examination.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 19-20, 22-39 and 55-66 rejected under 35 U.S.C. 103(a) as being unpatentable over Ebisawa (5,946,664 hereinafter Ebisawa) in view of Margulis (5,946,664 hereinafter Margulis).

With respect to claims 19-39 and 55-65, 67, 69,-70 Ebisawa teaches a removable moving media comprising: a source content including a moving video images presented within a video frame (video game); a removable content disposed within the moving video images of the source content providing a virtual product location, the virtual product location being movable within the video frame of the source content as the moving video images are presented(col. 3, lines 58-60), a communication assembly in connection with a virtual product source, the virtual product source providing access to the source content and the removable content (col. 3,lines 20-35, col. 5, lines 12-21,

30-35, col. 6, lines 10-20, 35-38, col. 6, lines 50- col. 8, line 25)., wherein the communication assembly is configured to cause the visual product source to place a virtual product within the source content of the removable moving media through utilization of the removable content disposed within the source content (col. 3, lines 58-60). Ebisawa also teaches a method for placement of visual product in a moving media, comprising selecting an original source media including a removable content, the removable content providing a visual product location (col. 3, lines 20-35, 01. 5, lines 12-20, 01. 7, lines 30-67), receiving a virtual product content from a peripheral visual product source (col. 7, lines 1-10, 30-67, col. 5, lines 12-20, col. 6, lines 12-19, lines 35-38)., editing the original source media and inserting the visual product content in the visual product location of the original source media (col. 3, lines 50-60, col. 7, lines 10-25). Ebisawa also teaches a system for placing virtual products within a moving media comprising an original moving media content source including a removable content, the removable content providing a visual product location (col. 3, lines 20-35)., a network in communication with the original moving media content source, the network providing a visual product source (figs, 7-9 and related text, col. 5, lines 12-20), a visual product disposed within the virtual product source, the visual product being enabled for placement in the virtual product location of the removable content (advertisements described; wherein the visual product is downloaded from the network and placed on the moving media in the virtual product location (col. 5, lines 12-20, lines 60-65, col. 3, lines 20-35, 55-60).

Ebisawa also teaches the visual product source is at least one of a network and

a peripheral computing system (col. 3, lines 60-65, col. 5, lines 12-20, figs. 7-9 and related text; the virtual product source updates the visual product location on the removable content within the source content (col. 5, lines 35-50), the source content is a video game (col. 1, lines 15-20) wherein the source content is at least on of a streaming video or video stream and a video file format (col. 7, lines 12-20, 50-60), the source content is a digital source content (col. 5, line 60 - col. 6, line 20). In this case, a virtual product refers to any object which is replaced or replaces in a scene for the purposes of providing advertising. To the extent that the claim to a visual product may be interpreted differently, it would have been obvious to one having ordinary skill in the art at the time of the invention to have used a virtual product in Ebisawa since product placement is well known in the art for product exposure and advertisement purposes and would have been adopted for the intended use of the artistic choices of the game manufacturer and sponsors). It also would have been obvious to have the virtual product placed within the moving media through a paint process since this would have been adopted for the intended use of providing static advertisements such as on the billboard of Ebisawa.

Ebisawa teaches the communication assembly allows the virtual product source to update a position of the virtual product location within the removable moving media (i.e. product B location is updated from a non-display location to a display location, the same applies for product D)(Figures 1A-1B and 2A-2B).

With respect to the newly amended feature of updating the position of the virtual

product location in the removable moving media through repositioning of the removable content relative to the source content (i.e. In Figures 1A-1B, and Figures 2A-2B, In order for advertisements A and C to be replaced with advertisements B and D, the location of advertisements A and C has to be changed in order for advertisements B and D to take it's place. Therefore advertisements B and D's location is also updated or improved from a non-display location to a display location).

Ebisawa substantially teaches the invention as described above, but does not show that the product is a commercial item associated with a brand identity or the commercial product comprises packaging containing a consumable product or a can of beer. Margulis teaches replacement of objects including a commercial item associated with a brand identity or the commercial product comprises packaging containing a consumable product (col. 16, line 59 - col. 17, line 5). It would have been obvious to one having ordinary skill in the art at the time of the invention to have inserted/replaced an object in Ebisawa as in Margulis since the objects of Margulis are used as advertisements and would have been adopted for the intended use of updated advertising. It also would have been obvious to have the commercial item as a can of beer since this would have been adopted for the intended use of a beer manufacturer advertising campaign.

With respect to claims 66 and 68, in addition to the limitations addressed above it further teaches the source content adhering to an MPEG-4 format. Official notice is taken that is old and well known in the computer related files for files to adhere to a MPEG-4 format because such a modification would provide a much smaller format without sacrificing quality. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the source content adhering to an MPEG-4 format in order to obtain the above mentioned advantage.

With respect to the position of the removable content being updated through repositioning without changing the virtual product in the virtual product location. Ebisawa teaches changing the virtual product location from a display position to a non-display position, in the case of displaying or not displaying product A, the virtual product A location is changed without changing the virtual product. The position of product A is repositioned from non display to display position.

### **Response to Arguments**

4. Applicant argues that Ebisawa doesn't teach repositioning of the removable content relative to the source content. The Examiner wants again to point out that in Ebisawa, Figure 3A, clearly teaches repositioning Advertisement A for advertisement C.
5. With respect to claim 66, Applicant argues that the claims call for repositioning without changing the virtual product in the virtual location. The Examiner again wants to point out that In Figures 1A-1B, and Figures 2A-2B, advertisements A and C are repositioned from a display position to a non-display position. Advertisements A and C are repositioned from display to non-display positions. The system can determine to re display products A and C and therefore, the virtual product wouldn't change.
6. With respect to Applicant argues that in Ebisawa, the positions of the advertisements data elements on the screen is not changed or reposition relative to the

source content. The Examiner disagrees with Applicant because as the user is playing a racing game, and "when a game program having the data structure shown in FIG. 3A is executed, commercial advertisement A is displayed in one scene of the auto racing program and advertisement C is displayed in another scene". As seen by Ebisawa above, as the scene (location) of the auto racing game changes so does the advertisements being displayed. Advertisements A wouldn't be displayed in the same scene as advertisement C. The ads are displayed relative to the scene being presented.

7. Applicant states that in Ebisawa, the location of advertisements A, B, C and D remains in the same location, even if the advertisements displayed are changed from A to B to C to D and so forth. The Examiner disagrees with Applicant because the advertisements position or location changes from a display position to an undisplayed position and from an undisplayed position to a displayed position, so therefore contrary to Applicant's, Ebisawa teaches that the advertisement data is charged or updated.

**Point of contact**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

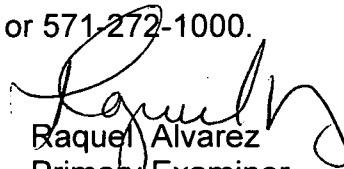
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Raquel Alvarez  
Primary Examiner  
Art Unit 3622

R.A.  
12/11/2007